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EXAMINER
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HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/336,611

Applicant(s)

REAY ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-41 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-41 and 45-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' Amendment D, paper number 14, filed on October 31, 2003. Claims 21 and 42-44 have been cancelled. New claim 48 has been added. Claims 1-20, 22-41, and 45-48 are pending and will be considered for examination.

### ***Drawings***

Figures 5 and 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 2 and 20 are objected to because of the following informalities: These claims recite the limitation "the unencrypted softgood" in lines 3 and 5 of the claims respectively. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claims 19 and 31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

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Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are directed to computer-readable mediums having computer-executable instructions for performing the steps of claims 8 and 20 respectively. These claims are improper because they fail the "infringement test" (see MPEP 608.01(n), Section III). Applying the Infringement test, what is needed to infringe claims 19 and 31 is, for example a CD-ROM having computer executable code that if and when executed would cause a computer to do the steps of recited in claims 8 and 20. However, such a CD-ROM would not infringe the method steps of claims 8 and 20 since the CD-ROM itself never performs any of the active steps required by the method of claims 8 and 20. In other words, mere possession of such a CD-ROM would infringe claims 19 and 31, but would not infringe claims 8 and 20. As such claims 8 and 31 are improper dependent claims.

### ***Final Rejection***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 20, 35, and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. These claims recite the negative limitation "unencrypted softgood". The Examiner notes that the specification does not describe the softgood as being "unencrypted". The specification is completely silent regarding the state of the softgood before, during, and after transfer. Indeed the term "unencrypted softgood" does not even appear anywhere in the specification. However, the Examiner notes that the specification explicitly teaches that other information relating to the purchase of the softgood is transmitted using a secure socket layer (SSL) (page 6, lines 3-8; page 12, lines 31-34; page 13, lines 33-35). For this reason, the limitation "unencrypted softgood" lacks proper written support in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the phrase "specific player program". It is unclear to the Examiner what this phrase means. For examination purposes, the Examiner will assume that this phrase means a proprietary player program.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 3, 4, 6, and 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Applicants' Admission of Prior Art (APA).**

Referring to claims 1, Wiser teaches a method and system for facilitating automated sale of softgoods (column 3, lines 5-10), comprising the steps of: providing a creator program to a creator of the softgoods that automatically includes a unique identifier in each softgood before the softgood is distributed to prospective purchasers, said unique identifier specifically referencing the creator of the softgoods (column 3, line 67; column 4, lines 1-3; column 6, lines 59-67; column 10, lines 49-55; column 11, lines 63-67; column 12, lines 1-11), the creator program producing softgoods that require the use of a specific player program to enable playback of softgoods authored with the creator program (column 4, lines 34-41; column 10, lines 1-17; Figure 14), the specific player program being configured to determine if the softgood is registered on the computing device on which the specific player program is installed before enabling playback of a softgood that was produced by the creator program, so that if a softgood is not registered on the computing device on which the specific player program is installed, the specific player program enables playback of said softgood in a demo mode, and if the softgood is registered on the computing device on which the specific player program is installed, the specific player program enables playback of said softgood in a full mode (column 4, lines 13-67; column 8, line 1 – column 9, line 36).

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Wiser teaches that a passport containing a certificate is stored on a user's computer (column 8, lines 44-48; Figure 4, items "400" and "402"). Wiser also teaches that when a user purchases a media file (i.e. softgood), the certificate containing the user's public key (Figure 4, item "404") is provided to a content manger which then uses the particular user's public key to encrypt the media key of the media file (column 9, lines 25-29). Moreover, Wiser teaches that when the media player receives the media file and encrypted media key it uses the user's private key contained in the passport (Figure 4, item "412") to decrypt the media key, which is then used to decrypt the media file (column 9, lines 30-33). Therefore, Wiser in effect teaches that if a softgood has not been properly registered on a user's computer then the media player will only be able to play a demo version since the media key needed to decrypt the encrypted portion of the file (Figure 2, item "208") will not be available. Wiser further teaches that a transaction ID that uniquely identifies each media file purchased is added to the media file (Figure 2, item "220"). This transaction ID includes, among other things, a media voucher ID and a certificate of the media player receiving the media file (column 8, lines 1-10). Wiser teaches that the media voucher ID controls the purchase and preview of the media data files (column 8, lines 18-20). Therefore, Wiser has several mechanisms to ensure that a softgood is properly registered. Wiser also teaches that the registration of the softgood is implemented by creating a registration value that is accessible by the computing device, a different registration value being created for each softgood registered on the computing device. This would correspond to the passport and media key combination and the transaction ID discussed above. Wiser also teaches

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distributing the softgoods to prospective purchasers, such that the distribution is not limited to a distribution over private networks (column 3, lines 5-20; column 6, lines 15-27). Wiser also teaches providing an agency having a server that implements softgood purchase transactions and maintains a database in which data relating to the sale of softgoods are stored (Figure 1B, items 124 and 130; column 5, lines 43-65; column 6, lines 4-14; column 9, lines 38-51), unique identifiers of the softgoods being referenced in the database to track the softgood purchase transactions (column 10, line 60 – column 11, line 7; column 11, lines 20-37), such that for softgoods that are purchased, the database maintains data relating to the purchasers of the softgoods for as long as the agency is managing purchases of the softgoods, said agency responding to a purchase of a softgood by transmitting the registration value identifying the softgood that was purchased to a first computing device used to initiate the purchase, so that a first copy of the specific player program installed on the first computing device will recognize that the softgood that was purchased is registered on the first computing device and thus enable playback of the softgood that was purchased in the full mode, whereas a second copy of the specific player program installed on a different computing device does not enable playback of the softgood that was purchased in full mode, unless the registration value for the softgood that was purchased is provided to the different computing device, thereby registering the softgood that was purchased on the different computing device (column 8, lines 44-48; Figure 4, items “400”, “402”, and “404”; column 9, lines 25-33). Wiser does not explicitly teach distributing the specific player program to prospective purchasers. However, Wiser teaches that the preview



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and the complete song are combined into a single media file (column 3, lines 51-63; column 7, lines 4-14, lines 56-62; Figure 2, items "208" and "214"). Wiser relies on streaming technology to deliver the preview portion of the media data file. However, streaming technology does not preclude a user from downloading a file. Indeed, Wiser specifically states "...a consumer should be able to pass on preview music to other potential new customers." (column 2, lines 17-18). How is this possible if the media data file is not made available for download? Furthermore, the Applicants admit that it is well known in the art to download software over the Internet (page 1, lines 12-27). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to download the entire media data file of Wiser onto a potential purchaser's system. The Examiner's notes that this is possible since Wiser uses encryption to secure the complete song from unauthorized access (column 7, lines 27-37). Once a user has registered with Wiser's system and provided payment, the system provides the key to decrypt the song (column 9, lines 25-37). One of ordinary skill in the art would have been motivated to do so in order to avoid requiring a user to download a second fully functional version as noted in the Applicants' specification (page 1, lines 22-23). Moreover, Wiser teaches that one of the problems with the current state of the art is that many products such as digital media and computer software are purchased on-line, but are delivered off-line (column 1, lines 10-29). Wiser purposes a complete system of online distribution that supports both purchase and delivery (column 1, lines 10-33). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to obtain the specific player program of Wiser over a

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public network. One of ordinary skill in the art would have been motivated to do so in order to take advantage of Wiser's system that supports both purchase and delivery over the Internet.

Referring to claims 3, 4, and 7, Wiser teaches all the limitations of claim 1 as noted above. Furthermore, Wiser teaches that the unique identifier of the softgood is assigned to a server (column 4, lines 1-12).

Referring to claim 6, Wiser teaches that the passport contains a registered user's identity (column 4, lines 42-50). Although Wiser discourages a user from sharing his or her passport with other users, nothing in the reference prevents a user from copying his or her passport to multiple computers that belong to the particular user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for a user to install a copy of the passport on several computers that the users owned. One of ordinary skill in the art would have been motivated to do so in order to allow the user to enjoy the softgood on several computers (e.g. laptops, desktops, etc.)

**Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Applicants' Admission of Prior Art and further in view of Rinearson "Word Processing Power with Microsoft Word".**

Wiser and Applicants' Admission of prior art do not teach that that the unique identifier for each softgood also references a unique identifier for the program provided to the creator, said program being used to create the softgood. However, Rinearson teaches that a program used by a creator of a softgood automatically adds an extension to the filename (page 54, see underlined portion). Specifically, Rinearson teaches that

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the program adds a ".DOC" extension to the filename. This extension inherently identifies the program used to create the softgood. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Rinearson into the method of the prior art. One of ordinary skill in the art would have been motivated to do so in order to automate the process of assigning filename extensions as taught by Rinearson. The cited prior art does not teach that the unique identifier distinguishes the specific copy of the creator program used by the creator from all other copies of the creator program. However, the Examiner notes that the limitation of claim 2 is not functionally involved in the steps of the method recited and is therefore considered to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what the unique identifier referenced. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the unique identifier reference any data because such data does not functionally relate to the steps of the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Applicants' Admission of Prior Art and further in view of Stefik et al (US Patent 5,629,980). Wiser and Applicants'**

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Admission of prior art teach all the limitations of claim 1 as noted above. Wiser and Applicants' prior art do not teach including a base price within each softgood prior to the step of distributing the softgood. However, Stefik teaches including a fee within each softgood prior to the step of distributing the softgood (column 6, lines 51-56). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the fee of Stefik into the method of the prior art. One of ordinary skill in the art would have been motivated to do so in order to automatically show the purchaser the price of the softgood prior to purchasing.

**Claims 8-12, 14, 17-19, 32, 35-37, 39-41, 45, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Applicants' Admission of Prior Art (APA) and further in view of Official Notice.**

Referring to claims 8, 9, 19, 32, and 35, Wiser teaches a method and computer-executable instructions for facilitating purchase of a softgood that is freely distributed to prospective purchasers for preview with a player program and which includes a unique identifier that is assigned to the softgood before the softgood is distributed, comprising the steps of: enabling the prospective purchasers to preview the softgood with the player program to a limited extent, prior to deciding to purchase the softgood, the player program controls access to the softgood and allows the prospective purchaser only limited access to the softgood (column 3, lines 51-63; column 10, lines 1-17), the player program being configured to determine if the softgood is registered on the computing device on which the specific player program is installed before enabling playback of a

softgood that was produced by the creator program, so that if a softgood is not registered on the computing device on which the specific player program is installed, the specific player program enables playback of said softgood in a demo mode, and if the softgood is registered on the computing device on which the specific player program is installed, the specific player program enables playback of said softgood in a full mode (column 4, lines 13-67; column 8, line 1 – column 9, line 36). Wiser teaches that a passport containing a certificate is stored on a user's computer (column 8, lines 44-48; Figure 4, items "400" and "402"). Wiser also teaches that when a user purchases a media file (i.e. softgood), the certificate containing the user's public key (Figure 4, item "404") is provided to a content manger which then uses the particular user's public key to encrypt the media key of the media file (column 9, lines 25-29). Moreover, Wiser teaches that when the media player receives the media file and encrypted media key it uses the user's private key contained in the passport (Figure 4, item "412") to decrypt the media key, which is then used to decrypt the media file (column 9, lines 30-33). Therefore, Wiser in effect teaches that if a softgood has not been properly registered on a user's computer then the media player will only be able to play a demo version since the media key needed to decrypt the encrypted portion of the file (Figure 2, item "208") will not be available. Wiser further teaches that a transaction ID that uniquely identifies each media file purchased is added to the media file (Figure 2, item "220"). This transaction ID includes, among other things, a media voucher ID and a certificate of the media player receiving the media file (column 8, lines 1-10). Wiser teaches that the media voucher ID controls the purchase and preview of the media data files (column 8,

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lines 18-20). Therefore, Wiser has several mechanisms to ensure that a softgood is properly registered. Wiser also teaches that the registration of the softgood is implemented by creating a registration value that is accessible by the computing device, a different registration value being created for each softgood registered on the computing device. This would correspond to the passport and media key combination and the transaction ID discussed above. Wiser also teaches enabling purchase of the softgood with the player program by connecting a computer on which the player program is executing with an e-commerce agency to initiate a network transaction, purchase of the softgood causing data related to the purchase to be recorded in the database of the e-commerce agency and causing a registration value that references the unique identifier to be transmitted to the computer on which the player program is executing (column 3, lines 32-50; column 9, lines 26-36; column 10, lines 18-37); registering the softgood on the computer employed for the network transaction using the registration value provided by the e-commerce agency, registration of the softgood on the computer enabling the softgood to be played by the player program beyond the limited extent of the preview, the player thereafter allowing a purchaser who has thus purchased the softgood to fully access the softgood (column 3, lines 32-50; column 9, lines 25-36; column 10, lines 1-37). Wiser does not explicitly teach that the prospective purchaser possesses a complete copy of the softgood. However, Wiser teaches that the preview and the complete song are combined into a single media file (column 3, lines 51-63; column 7, lines 4-14, lines 56-62; Figure 2, items "208" and "214"). Wiser relies on streaming technology to deliver the preview portion of the media data file.

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However, streaming technology does not preclude a user from downloading a file.

Indeed, Wiser specifically states "...a consumer should be able to pass on preview music to other potential new customers." (column 2, lines 17-18). In addition, Wiser uses encryption to secure the complete song from unauthorized access (column 7, lines 27-37). Once a user has registered with Wiser's system and provided payment, the system provides the key to decrypt the song (column 9, lines 25-37). Furthermore, the Applicants admit that it is well known in the art to download a demo version of a software that can be unlocked to provide full functionality (page 1, lines 12-27).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to download the entire media data file of Wiser onto a potential purchaser's system. One of ordinary skill in the art would have been motivated to do so in order to avoid requiring a user to download a second fully functional version as noted in the Applicants' specification (page 1, lines 22-23). Wiser also does not explicitly teach that the softgood is previewed and purchased from **within** the player program.

However, Official Notice is taken that modular programming is well known in the art.

Modular programming reduces a complex program into several smaller programs that are equivalent in function to the original program. However, there is no requirement that a programmer use modular programming. Indeed a programmer may combine several modules into one large program. The choice of using several modules or one large program is one that a programmer makes at the time of design and implementation of the program. Therefore integrating several separate modules into one program would have been obvious since it has been held that making something integral is within the

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level of ordinary skill in the art, see *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA 1965); *In re Wolfe*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958).

Referring to claims 10 and 11, Wiser teaches the steps of using the player program to transmit an identification of a purchaser of the softgood to the e-commerce agency during the network transaction, to enable the e-commerce agency to debit a financial account of the purchaser for a purchase price of the softgood, wherein the financial account numbers of purchasers of softgoods are stored in a database, a financial account number of a purchaser being used to debit an account of said purchaser as a result of the network transaction (column 13, lines 4-58).

Referring to claims 12, 36, and 37, Wiser teaches the step of modifying the softgood to include the registration value and recording the registration value in a file, said registration value referencing the identification of the user (column 4, lines 42-50; column 9, lines 11-18; column 19, lines 61-67; column 20, lines 1-8). The Examiner also notes that the limitations of claim 34 are deemed to be nonfunctional descriptive material since the structural elements of the system would be the same regardless of what information the registration value included, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the unique identifier reference any data because such data does not functionally relate to the structural elements of the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.



Referring to claim 17, Wiser teaches the step of permitting the softgood to be played with only a substantially reduced quality, unless registered on the computer (column 3, lines 51-63).

Referring to claim 18, Wiser does not explicitly teach the step of sending a message over the network to advise a purchaser of the registration value that was used to register the softgood on the computer of the purchaser. However, Official Notice is taken that it is old and well known in the art to advise a purchaser of the registration value that was used to register a softgood on a computer in order to allow a purchaser to retain the registration value for recording keeping purposes.

**Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Stefik et al (US Patent 5,629,980).**

Referring to claim 13, Wiser does not teach the step of including a prohibition of a purchaser modifying the softgood within the softgood. However, Stefik teaches prohibiting the purchaser from modifying the softgood (column 9, line 8; column 11, lines 33-34; column 40, lines 47-67; column 41, lines 1-39). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Stefik into the method and computer program of Wiser. One of ordinary skill in the art would have been motivated to do so in order to protect the authenticity of the softgood.

**Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Rinearson "Word Processing Power with Microsoft Word".**

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Wiser and Applicants' Admission of prior art do not teach that that the unique identifier for each softgood also references a unique identifier for the program provided to the creator, said program being used to create the softgood. However, Rinearson teaches that a program used by a creator of a softgood automatically adds an extension to the filename (page 54, see underlined portion). Specifically, Rinearson teaches that the program adds a ".DOC" extension to the filename. This extension inherently identifies the program used to create the softgood. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Rinearson into the method of the prior art. One of ordinary skill in the art would have been motivated to do so in order to automate the process of assigning filename extensions as taught by Rinearson. Furthermore, the Examiner notes that the limitation of claim 15 is not functionally involved in the steps of the method recited and is therefore considered to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what the unique identifier referenced. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the unique identifier reference any data because such data does not functionally relate to the steps of the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Ronning (US Patent 5,883,955). Wiser teaches the limitations of claim 8 as noted above. Wiser does not teach that the softgood is not usable on the computer for more than a predefined number of times, unless registered on the computer. However, Ronning teaches this limitation (column2, lines 26-29; claim 5). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Ronning into the method of Wiser. One of ordinary skill in the art would have been motivated to do so in order to persuade the user to purchase the softgood.

**Claims 20, 22-24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronning (US Patent 5,883,955) in view of Official Notice and further in view of Richardson III (US 5,490,216).**

Referring to claims 20 and 31, Ronning teaches a method and computer-readable medium having computer-executable instructions for controlling play of a softgood on a computer using a player program, said player program also being employed to purchase the softgood through a network transaction (column 3, lines 50-66; column 4, lines 46-49; Figure 2, items 18, 40, and 42), comprising the steps of: enabling a user to preview the softgood on the computer with a player program (column 4, lines 56-67; column 5, lines 1-3; Figure 3, item 46), the player program being configured to determine if the unencrypted softgood is registered on the computing device on which the specific player program is installed before enabling playback of a

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softgood that was produced by the creator program, so that if a softgood is not registered on the computing device on which the specific player program is installed, the specific player program enables playback of said softgood in a demo mode, and if the softgood is registered on the computing device on which the player program is installed, the player program enables playback of said softgood in a full mode (column 3, lines 44-48; column 4, lines 17-22). Wiser also teaches enabling the user to purchase the softgood through a transaction conducted with a player program, such that after the user has purchased the softgood, the softgood is registered on the computer using a registration value provided during the transaction, registration of the softgood on the computer providing access to the softgood in accord with a license to the softgood so that it is thereafter playable on the computer with the player program beyond the preview limit. (column 5, lines 4-15; column 11, lines 1-33; column 12, lines 12-22). Ronning does not explicitly teach that the registration value identifies a software program used to create the softgood. However, this limitation is not functionally involved in the steps of the method recited and is therefore considered to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what the registration value identified. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the registration value identify any data because such data

does not functionally relate to the steps of the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Ronning also does not explicitly teach that the softgood is previewed and purchased from *within* the player program. However, Ronning states "Fig.3 is one example of user interfaces for a software or digital information distribution system. Other user interfaces or ways of allowing a user to interact with the system are possible for such a system." (column 5, lines 12-15). Furthermore, Official Notice is taken that modular programming is well known in the art. Modular programming reduces a complex program into several smaller programs that are equivalent in function to the original program. However, there is no requirement that a programmer use modular programming. Indeed a programmer may combine several modules into one large program. The choice of using several modules or one large program is one that a programmer makes at the time of design and implementation of the program. Therefore integrating several separate modules into one program would have been obvious since it has been held that making something integral is within the level of ordinary skill in the art, see *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA 1965); *In re Wolfe*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958).

Referring to claims 22 and 23, Ronning teaches all the limitations of claim 21 as noted above. Ronning does not teach the limitations of claims 22 and 23. However, Richardson III teaches a method of registering softgoods wherein if the softgood is transferred to a different computer after being purchased, the softgood must again be registered on the different computer to enable the softgood to be played beyond the

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preview limit on the different computer (column 2, lines 52-55; column 6, lines 34-67, column 7, lines 1-67; column 8, lines 1-38). Furthermore Richardson teaches that the registration value includes at least a name of the purchaser of the softgood (column 8, lines 15-22). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Richardson into the method of Ronning. One of ordinary skill in the art would have been motivated to do so in order to ensure that a purchaser had followed proper licensing procedures of the softgood. The Examiner also notes that the limitations of claim 23 are deemed to be nonfunctional descriptive material since the steps of the method would be performed the same regardless of what information the registration value included, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the unique identifier reference any data because such data does not functionally relate to the steps of the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 24, Ronning teaches the steps of confirming that a financial account number is valid and transmitting a registration value to the purchaser (column 11, lines 1-28).

**Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronning and Bernard et al (US 5,918,213) and further in view of Microsoft Press Computer Dictionary.**

Referring to claim 25, Ronning teaches all the limitations of claim 21 as noted above. Furthermore, Ronning teaches storing the registration value so that the purchaser can again reregister the softgood on a computer (column 11, lines 9-13). Ronning does not teach maintaining a database on an e-commerce server in which an identification of each purchaser and a list of each softgood purchased by each purchaser are included, to facilitate distribution of at least a portion of the purchase price of the softgood to a creator of the softgood. However, Bernard teaches the use of a database to facilitate the distribution of at least a portion of the purchase price of the softgood to a creator of the softgood (column 30, lines 42-67). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the method Ronning. One of ordinary skill in the art would have been motivated to do so in order to ensure that the creator was paid for his or her work.

Referring to claim 26, Ronning and Bernard teach all the limitations of claim 25 as noted above. Furthermore, Bernard teaches that the data stored in the database also includes a financial account number for each purchaser of softgoods, said financial account numbers being provided by the purchasers, further comprising the step of charging the financial account referenced by the financial account number of a purchaser during the transaction (column 3, lines 63-67; column 4, lines 1-20). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the method of

Ronning. One of ordinary skill in the art would have been motivated to do so in order to automate the purchase transaction for the purchaser.

Referring to claims 27 and 28, Ronning and Bernard teach all the limitations of claim 26 as noted above. Ronning and Bernard do not teach using the player program to encrypt a financial account number for transmission over a network. However, Microsoft Press teaches a method of Secure Socket Layer (SSL) which is used to encrypt and transmit financial account numbers over a network (page 425-426). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the SSL standard as taught by Microsoft in the method of Ronning and Bernard. One of ordinary skill in the art would have been motivated to do so in order to prevent interception of critical information.

Referring to claim 29, Ronning and Bernard teach all the limitations of claim 25 as noted above. Furthermore Bernard teaches that the database includes a current price for each softgood, and the step of advising a purchaser of the current price of the softgood being purchased during the transaction (column 10, lines 24-48). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the method of Ronning. One of ordinary skill in the art would have been motivated to do so in order to allow the purchaser to decide whether to actually purchase the product.

**Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ronning in view Official Noticew and further in view of Microsoft Press Computer Dictionary.** Ronning teaches the limitations of claim 21 as noted above. Ronning does



not teach that the player program transmits information over a network using a secure communication protocol. However, Microsoft Press teaches a method of Secure Socket Layer (SSL) which is used to encrypt and transmit financial account numbers over a network (page 425-426). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the SSL standard as taught by Microsoft in the player program of Ronning. One of ordinary skill in the art would have been motivated to do so in order to prevent interception of critical information.

**Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Bernard et al (US 5,918,213).** Wiser teaches all the limitations of claim 32 as noted above. Furthermore, Bernard teaches checking the data stored in the database to determine if data for the user purchasing a softgood are already included within the database (column 3, lines 63-67; column 4, lines 1-20), and if so using a financial account number included in the data for implementing the purchase of the softgood (column 10, lines 39-48). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the system of Ronning and Stefik. One of ordinary skill in the art would have been motivated to do so in order to automate the transaction for the purchaser.

**Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Richardson III (US 5,490,216).** Wiser teaches all the limitations of claim 32 as noted above. Wiser does not teach the limitation of claim 34. However, Richardson teaches

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that the registration value includes at least a name of the purchaser of the softgood (column 8, lines 15-22). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Richardson into the system of Wiser. One of ordinary skill in the art would have been motivated to do so in order to ensure proper licensing procedures of the softgood. The Examiner also notes that the limitations of claim 34 are deemed to be nonfunctional descriptive material since the structural elements of the system would be the same regardless of what information the registration value included, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the unique identifier reference any data because such data does not functionally relate to the structural elements of the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Response to Arguments***

Applicants' arguments in response to a possible restriction between "softgood" and "unencrypted softgood" have been fully considered and are persuasive. Therefore, there will be no restriction. The Examiner will examine both sets of claims.

Applicants' amendments and arguments in response to the Examiner's 112, 1<sup>st</sup> paragraph rejection of claims 1, 20, and 35 have been fully considered and are sufficient to overcome the rejection. Therefore the rejection is hereby withdrawn.

Applicants' arguments and amendments in response to the Examiner's 112, 2<sup>nd</sup> paragraph rejection of claims 1, 32, 45, and 47 have been fully considered and are persuasive. Therefore the rejection is hereby withdrawn.

Applicants' amendments in response to the Examiner's objection to claim 46 are sufficient to overcome the objection. Therefore the objection is hereby withdrawn.

Applicants' arguments with respect to a possible rejection under enablement regarding the use of the term "unencrypted softgood" in the claims are duly noted. However, the Examiner would like to point out that "lack of enablement" was never an issue. During a telephonic interview with the Attorney of Record on October 14, 2003, the Examiner stated that the specification lacked proper support (i.e. written description requirement) for the use of the term "unencrypted softgood". The written description requirement is separate and distinct from the enablement requirement under 112, 1st paragraph (See MPEP 2106.01 and 2163). In the present case, the Applicants have introduced the negative limitation "unencrypted softgood" into claims 2, 20, 35, and 48. The Examiner would like to point out that the term "softgood" is a term which the Applicants created to describe their invention. Therefore the Applicants are responsible for defining this term. An applicant is entitled to be his or her own lexicographer, and in any instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro C. v. White Consolidated Industries Inc.* 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed Cir. 1999). Inventor may define specific terms used to describe invention, but must do so

with reasonable clarity, deliberateness, and precision. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (fed. Cir. 1992)). The Applicants' specification teaches that a "softgood" is a digital product such as music or video files (page 2, lines 6-11; page 7, lines 6-13). As noted above, under 112, 1<sup>st</sup> paragraph, the specification is completely silent regarding the state of the softgood before, during, and after transfer. Therefore the negative limitation "unencrypted softgood" lacks proper written support. The Applicants have argued that the term "softgood" encompasses both encrypted and unencrypted softgoods, and that the Applicants are merely narrowing their invention by the use of the term "unencrypted softgood" (see Amendment D, page 30, line 9 – page 33 line 11). However, the Applicants have chosen to narrow their invention by using a negative limitation that lacks proper written support in the specification. There is nothing in the specification which would guide one of ordinary skill in the art to conclude that an encrypted softgood was excluded from the Applicants' invention as the Applicants are now requiring in the claim language. The Applicants have also argued that the means of distribution and the nature of the invention (i.e. allowing the softgood to be freely distributed) are sufficient support for the term "unencrypted softgood". The Examiner disagrees. First, the decision to encrypt data is usually based on the nature and content of the data and not on the means of distribution. Therefore distributing data via a memory media does not inherently preclude encrypted data as the Applicants have claimed in the claim language. Secondly, the fact that the softgood is freely available also does not inherently preclude encrypted data. To support this, the Examiner cites the Wiser reference. Wiser

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teaches a softgood that has encrypted data (Figure 2, item "208") and is intended to be freely distributed (column 2, lines 17-18). For these reasons, the negative limitation "unencrypted softgood" lacks proper written support.

Applicants' arguments with respect to the Examiner's rejection of claims 1, 3, 4, 6, and 7 under 35 U.S.C. 103 over Wiser in view of APA have been fully considered but they are not persuasive. The Applicants have argued that the recited combination would not work because the locking feature of APA is inconsistent with Wiser's passport. The Applicants have misunderstood the Examiner's rejection. The Examiner cited APA because the Applicants admit that downloading software over the Internet is old and well known. Wiser relies on streaming technology to deliver the preview portion of the media data file. Wiser also has references to downloading software over the Internet as noted above. However, since the Applicants have already admitted that downloading a demo version of a software over the Internet is well known, the Examiner relied on this to further support the argument that any modification to Wiser incorporating this such a download – assuming such a modification was even necessary – would have been obvious to one of ordinary skill in the art. The Applicants appear to be arguing that downloading a demo version of a software over the Internet would not have been obvious to someone reading Wiser's patent even though they admit in their specification that this feature is old and well known. The Examiner disagrees with this conclusion, and maintains the art rejection. This argument applies to claim 8 as well.

Applicants' arguments with respect to the Examiner's rejection of claims 8-12, 14, 17-19, 32, 35-37, 39-41, 45, and 47 under 35 U.S.C. 103 over Wiser in view of APA and

Official Notice have been fully considered but they are not persuasive. Referring to claim 8, the Applicants believe that Wiser is limited to streaming delivery of a media file as opposed to delivering the whole file. The Examiner disagrees because Wiser places no such restriction on his invention. As already explained above, Wiser's intent is to allow users to pass on preview music to other potential customers (column 2, lines 17-18). Wiser never explicitly limits his invention to streaming delivery only. Referring to the Applicants' arguments regarding modular programming, the Examiner's disagrees with the Applicants. Whether the transaction occurs with a player program or a web browser is immaterial since eventually a system call to the operating system must be made which in turn invokes a networking module to establish a network connection. Merely adding a networking module to a player program, which in turn would make a call to the OS for a network connection, is an obvious modification as already noted above.

Since the Applicants have failed to seasonably challenge the Examiner's Official Notice presented in the previous Office Actions, the Examiner now interprets all Official Notices as admitted prior art. *Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946). If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d71, 60 USPQ 239 (CCPA 1943). Also see MPEP 2144.03.*

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.

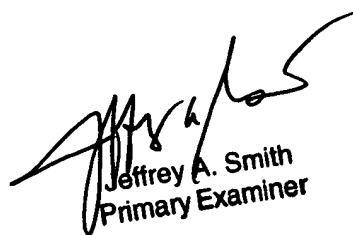
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**Naeem Haq**, Patent Examiner

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January 26, 2004



Jeffrey A. Smith  
Primary Examiner